

REMARKS

I. Summary of Office Action

Claims 1-21 are pending in the application.

The Examiner rejected claims 1-6, 8, 9, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate et al. U.S. Patent No. 6,601,237 (hereinafter "Ten Kate") in view of Ficco U.S. Patent Application Publication No. 2005/0166224 (hereinafter "Ficco"). The Examiner rejected claims 7, 10-13, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco and further in view of Picco et al. U.S. Patent No. 6,029,045 (hereinafter "Picco"). The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco and further in view of Kunkel et al. U.S. Patent Application Publication No. 2002/0056093 (hereinafter "Kunkel").

The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Picco.

The Examiner rejected claim 20 under 35 U.S.C. § 102(e) as being anticipated by Ficco.

The Examiner rejected claim 21 under 35 U.S.C. § 102(e) as being anticipated by Klosterman et al. U.S. Patent Application Publication No. 2001/0013124 (hereinafter "Klosterman").

II. Summary of Applicants' Reply

Applicants have amended independent claims 1, 16, 19, and 21 in order to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

The Examiner's rejections of the claims are respectfully traversed.

Reconsideration of this application is respectfully requested.

III. The Rejection of Claims 1-19 Under 35 U.S.C. § 103(a)

The Examiner rejected each of pending independent claims 1 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco. The Examiner also rejected independent claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Picco. The Examiner's rejection of these claims under this section is respectfully traversed.

Applicants respectfully submit that, contrary to the Examiner's contention, each of independent claims 1, 16, and 19 is allowable for at least the reasons set forth below.

A. Applicants' Independent Claims 1, 16, and 19 are Allowable Over Ten Kate

Applicants' independent claim 1 relates to a method for creating a plurality of non-interactive personalized advertisements to be viewed by an intended audience. As defined by independent claim 1, this method includes:

- creating a personalized advertisement template comprising a plurality of media slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots;

- providing a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of media segments for said at least one of said slots, wherein said media segments are synchronized to begin and end at substantially the same time; and

- providing content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized media segments, to allow said receiving unit to select among said plurality of data streams for one of said media segments for said particular slot, to assemble a non-interactive personalized advertisement.

Ten Kate, on the other hand, discusses methods and systems for rescheduling programming conflicts using a virtual channel. (*See, e.g.*, Ten Kate, Abstract.) More particularly, as shown in FIG. 4, in Ten Kate, a virtual channel that includes content from channel A, channel B, and a VCR. The VCR is used to record desired programs that are being broadcast at the same time. The user assigns priorities that determine which program is watched and which program is recorded. The recorded program is placed into a gap where no desired programming is being provided.

Applicants respectfully submit that, contrary to the Examiner's contention, Ten Kate in combination with Ficco does not show or suggest the method defined by independent claim 1 for at least the reasons set forth below.

(i) **Ten Kate Does Not Show or Suggest an Advertisement Template**

As recited above, applicants' claim 1 requires "an advertisement template comprising a plurality of slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots." As explained in applicants' specification, "[t]he narrative framework for the final personalized message is a story as defined by a message campaign. The advertisement campaign includes an advertisement template and a collection of media segments." The media segments (e.g., audio, video, background, animation, graphs, voice, etc.) are selected and then assembled to produce the final personalized advertisement at assembly time. (See, e.g., Applicants' specification, page 6, lines 8-19.)

Contrary to the Examiner's suggestion on page 6 of the Office Action, Ten Kate does not show or suggest "an advertisement template" that includes a plurality of media slots in sequence, where a plurality of media segments are insertable into at least one of the plurality of slots. Rather, Ten Kate merely shows a Service Description Table and Event Description Tables that an electronic program guide uses to generate an on-screen display of program listings. An electronic guide display is not an advertisement nor is it a template for generating a personalized advertisement.

In addition, applicants wish to point out to the Examiner that the program guide of Ten Kate is presented to the viewer. Unlike Ten Kate, applicants' system of claim 1 uses the advertisement template to assemble the personalized advertisement. It is the personalized advertisement that is viewed by the intended audience, not the advertisement template.

Accordingly, applicants respectfully submit that Ten Kate fails to show or suggest a method including, among other things, "creating a personalized advertisement template comprising a plurality of slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots."

(ii) **Ten Kate Does Not Show or Suggest
A Plurality Of Different Media Segments**

As recited above, applicants' claim 1 requires "a plurality of different media segments [that] are insertable into at least one of said slots." Contrary to the Examiner's suggestion on

page 6 of the Office Action, for at least the following reasons, Ten Kate does not show or suggest this element of applicants' claimed invention.

As explained above, Ten Kate does not show or suggest an advertisement template that includes a plurality of slots in sequence. In fact, the electronic program guide of Ten Kate is not capable of including media slots. Applicants submit that Ten Kate has nothing to do with media slots. Instead, Ten Kate uses a user selectable virtual channel to solve programming conflicts. When two desired program are simultaneously broadcast, the Ten Kate system records the program with the lower user assigned priority rating and reschedules it at a later time using the virtual channel. The virtual channel tunes to the appropriate channel for broadcast programs or the VCR for recorded programs. (*See* Ten Kate, col. 6, lines 47-62.) Thus, media segments cannot be inserted into the virtual channel of Ten Kate.

Accordingly, because Ten Kate fails to show or suggest any use of "media slots" and "different media segments," applicants respectfully submit that Ten Kate must also fail to show or suggest a method including "creating a personalized advertisement template comprising a plurality of media slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots."

**(iii) Ten Kate Does Not Show or Suggest Assembling
A Non-Interactive Personalized Advertisement**

As recited above, applicants' claim 1 requires "assembl[ing] a non-interactive personalized advertisement."

In contrast to applicants' claimed invention, Ten Kate does not show or suggest assembling a non-interactive personalized advertisement. Instead, as described above, Ten Kate uses a user selectable virtual channel to solve programming conflicts. Based on user assigned priority ratings, the virtual channel merely tunes to the appropriate channel for broadcast programs (e.g., CH-A, CH-B) or the VCR for recorded programs (e.g., VCR) (*See* Ten Kate, FIG. 4). Nowhere is it shown or suggested that Ten Kate assembles a personalized advertisement.

In addition, the virtual channel of Ten Kate tunes to a channel or the VCR based on priority ratings that are assigned by the user (i.e., with interaction by the intended audience). In

order to fill a gap, the virtual channel module is capable of controlling the tuner and the demultiplexer to select a default channel. The identification of the default channel can be “chosen or altered by the user.” (See Ten Kate, col. 6, lines 5-6.) Ten Kate clearly does not assemble a “non-interactive personalized advertisement,” as required by claim 1.

Accordingly, applicants respectfully submit that Ten Kate fails to show or suggest a method including, among other things, “assembl[ing] a non-interactive personalized advertisement.”

In view of the foregoing, applicants respectfully submit that independent claim 1 is allowable over Ten Kate in view of Ficco. Therefore, applicants respectfully request that the rejection of claim 1 be withdrawn by the Examiner.

Similarly, independent system claims 16 and 19 are allowable for at least the same reasons. Therefore, applicants respectfully request that the rejection of independent claims 16 and 19 also be withdrawn by the Examiner.

The Examiner rejected each of dependent claims 2-15, 17, and 18 under 103(a) as being unpatentable over Ten Kate. In particular, the Examiner rejected claims 2-6, 8, 9, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco. The Examiner rejected claims 7, 10-13, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco and further in view of Picco. The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Ten Kate in view of Ficco and further in view of Kunkel. Applicants respectfully submit that claims 2-15, 17, and 18, each of which depends from one of independent claims 1 and 16, are allowable for at least the same reasons that the independent claims are patentable as set forth above.

IV. The Rejection of Claims 21 Under 35 U.S.C. § 102(e)

Applicants’ independent claim 21 relates to a method for delivering a plurality of different non-interactive personalized advertisements over a television transmission network. As defined by independent claim 21, this method includes:

creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-interactive advertisement;

transmitting a plurality of television programs to a television signal receiver, wherein said plurality of television programs have at least one synchronized commercial break;

during said synchronized commercial break, transmitting said plurality of different media segments to said television signal receiver, wherein all media segments in said at least one subset are transmitted simultaneously;

directing said television signal receiver to switch to one of said media segments in said subset as said media segments in said subset are received to assemble said complete non-interactive advertisement; and

wherein after said synchronized commercial break, said television signal receiver switches to a previously selected television program.

Klosterman, as described by the Examiner, discusses methods and systems for replacing television signals according to pre-established criteria. Klosterman does this by transmitting multiple channels and monitoring those channels. In response to the pre-established criteria, the Klosterman system tunes between those channels to provide the desired programming to a television, where the change channel command to tune to a particular channel is transmitted in the vertical blanking interval (VBI) of one or more channels.

Applicants respectfully submit that, contrary to the Examiner's contention, Klosterman does not show or suggest "creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-interactive advertisement."

First, unlike applicants' independent claim 21, Klosterman makes no mention of "creating a plurality of different video and audio media segments, wherein said different segments include incomplete sections of a complete non-interactive message." On the contrary, Klosterman tunes to a channel that is providing only completed programming. For example, Klosterman states that:

a viewer is watching the SuperBowl on the viewer's television set that is tuned to Channel A. Channel A interrupts the SuperBowl program to show a beer commercial. The viewer's television is programmed to recognize and execute the VBI change channel command. When the viewer's television encounters the VBI change channel command, the viewer's television tunes to Channel B. Channel B shows a commercial for a nationally recognized brand of athletic shoes. When the commercial on Channel B is complete, the viewer's television is programmed to return to Channel A. The change of channels is invisible to the viewer. (Klosterman, paragraph [0045].)

Nowhere does Klosterman show or suggest that the programming on Channel B may include audio and/or video segments that are “incomplete sections of a complete non-interactive message.” Even in the example given in Klosterman, the television tunes back to Channel A, “[w]hen the commercial on Channel B is complete.” Accordingly, applicants respectfully submit that Klosterman fails to show or suggest a method that includes “creating a plurality of different video and audio media segments, wherein said different segments include incomplete sections of a complete non-interactive message.”

In addition, Klosterman does not show or suggest assembling a “complete non-interactive advertisement,” as required by claim 21. Instead, as described above, Klosterman uses the VBI to tune to a different channel providing only completed programming. Based on pre-established criteria, an instruction that is recognized by the viewer’s television directs the television to tune to a different channel that is providing the desired programming. Nowhere is it shown or suggested that Klosterman assembles a personalized advertisement.

Accordingly, applicants respectfully submit that Klosterman also fails to show or suggest a method including, among other things, “assembl[ing] said complete non-interactive personalized advertisement.”

In view of the foregoing, applicants respectfully submit that independent claim 21 is allowable over Klosterman. Therefore, applicants respectfully request that the rejection of claim 21 be withdrawn by the Examiner.

V. Conclusion

The foregoing demonstrates that claims 1-19 and 21 are patentable. This application is therefore in condition for allowance. Reconsideration and prompt allowance are accordingly respectfully requested.

VI. Authorization

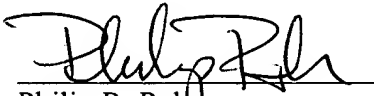
The Director is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Director is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,

WILMER CUTLER PICKERING
HALE AND DORR LLP

Date: October 19, 2006


Philip R. Poh
Registration No. 51,176
Agent for Applicants

Wilmer Cutler Pickering
Hale and Dorr LLP
399 Park Avenue
New York, NY 10022
Tel. 212-230-8800
Fax. 212-230-8888
Customer No. 28089